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AS

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/322,333 | 05/28/99 | KONDO | T 1217-990766 |

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IM22/0117

EXAMINER

DEAN, F

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1771

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DATE MAILED: 01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/322,333

Applicant(s)

KONDO ET AL.

Examiner

Frederick G. Dean

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1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 and 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC §§ 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 4 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagamoto et al. (EP 0798355A2).

Applicants broadly claim a pressure-sensitive adhesive sheet comprising a pressure-sensitive adhesive layer and a substrate exhibiting certain viscoelastic properties.

Nagamoto et al. disclose a pressure-sensitive adhesive sheet comprising a pressure-sensitive adhesive layer and a photocurable resin substrate composed of the urethane acrylate oligomer and polyene thiol resin in Applicants' preferred embodiment as noted on page six of the specification. (See, page 3, lines 9 – 20.)

The Examiner deems the properties of the substrate as defined in claims 1 and 2 to be inherent or obvious within the invention of patentees. Nagamoto et al., described above, disclose all of the claim limitations except for the properties of the substrate as

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defined in claims 1 and 2. However, since Nagamoto et al. use the same materials as the Applicants in the same amounts as the Applicants, and it appears that the substrate of Nagamoto et al. is structurally and chemically identical as the Applicants' substrate, it is the Examiner's position that the substrate of Nagamoto inherently exhibits an identical dynamic viscoelasticity (claim 1) and Young's modulus (claim 2) as the Applicants' claimed substrate. In addition, the presently claimed viscoelasticity and modulus properties would obviously have been provided in the product of Nagamoto et al. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102. Nagamoto et al. either anticipates or strongly suggests the claimed subject matter.

Finally, the Examiner cursorily renders nominal the methods of use of claims 3 and 4 because these uses are clearly within the skill of the art for which the article is intended.

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Frederick G. Dean whose telephone number is 703-305-0547. The Examiner can normally be reached from 08:00 - 16:30 M-F.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached at 703-308-2414. The fax phone numbers for the Technology Center 1700 are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1495.

Frederick G. Dean

Frederick G. Dean
Patent Examiner

January 12, 2000

Blaine Copenheaver
BLAINE COPENHEAVER
PRIMARY EXAMINER